RESPONSE AND REMARKS

Claims 1-63 were previously cancelled and Claims 64-79 were previously added to more distinctly claim the invention. Reconsideration of the application in view of the Response and Remarks below are respectfully requested.
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REJECTIONS UNDER SECTION 103(a)

In the Office Action, Claims 64-67 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kara et al. (U.S. Patent No. 6,233,568; "*Kara*") in view of Thiel, "U.S. Patent No. 6,699,258"; (U.S. Patent No. 5,699,258; "*Thiel*"). *Office Action*, Topic No. 3, p. 2.

The Office Action rejected Claims 68-79 under 35 U.S.C. §103(a) as being unpatentable over *Kara* and *Thiel*, and further in view of UPS® Service Guide (www.ups.com; "*UPS*") and FedEx® Services (www.fedex.com; "*FedEx*") and Barnett et al. (U.S. Patent No. 6,369,840; "*Barnett*"). *Office Action*, Topic No. 8, p. 4.

The Office Action states, with respect to the rejection of Claims 64, and 68-79, that: "Kara discloses the use of shipping management computer system (see abstract) for:"

a. Receiving a set of package specifications (Fig. 8, Box 802);
b. Determining multiple shipping rates (first and second) for a first carrier (Fig. 8, Boxes 807 and 808);
c. Determining multiple shipping rates (third and fourth) for a second carrier (Fig. 8, Boxes 807 and 808);
d. Receiving a request from a user to ship a package using one of the services by one of the carriers (See Fig. 8, Col. 5, lines 56-67);
e. Facilitating the delivery of the package (Col. 6, lines 1-6).

Office Action, Topic No. 4, pgs. 2-3; *Office Action*, Topic No. 9, p. 4.

The Office Action further states that "Kara ... fails to disclose the simultaneous display of the rates for each carrier that includes rates of different services...." *Office Action*, Topic No. 5, p. 3; *Office Action*, Topic No. 10, p. 4. *Thiel* is then cited to support of the assertion that "Thiel discloses the use of a system for calculating rates for

multiple carriers for multiple services (see abstract), and discloses the computer storing data for the rates of each service for each carrier in one table (Column 11, lines 1-13)." *Office Action*, Topic No. 5, p. 3; *Office Action*, Topic No. 10, p. 4.

According to the Office Action, "Thiel also discloses that the system will walk the user through which service is wanted, however discloses displaying only the final rate for desired service for multiple carriers (Column 11, lines 46-54)." *Office Action*, Topic No. 5, p. 3; *Office Action*, Topic No. 10, pgs. 4-5. The Office Action then states that although "Kara and Theil [sic] fail to disclose the 'simultaneous' display of shipping charges for each service of each carrier.... It would have been obvious ... to display all charges simultaneously." *Office Action*, Topic No. 6, p. 3; *Office Action*, Topic No. 11, p. 5.

The Office Action then states that "[t]he way something is displayed, is not considered to be patentable over the prior art of record, therefore it would have been obvious ... to display all the calculated rates simultaneously for comparison purposes." *Office Action*, Topic No. 6, p. 3; *Office Action*, Topic No. 11, p. 5.

With respect to the rejection of Claims 68-79, the Office Action states that "... Kara does not specifically disclose the rates being calculated with respect to day and time." *Office Action*, Topic No. 12, p. 5. The Office Action asserts though, that "[b]oth UPS® and FedEx® disclose specific services where they are guaranteed delivery by a certain time in the day. It would have been obvious ... to include the time sensitive 'urgency' services, as disclosed by FedEx® and UPS®, in order to ship thing and compete with a time advantage using guaranteed delivery times and to reduce costs, when delivery time is not of importance." *Office Action*, Topic No. 12, p. 5 (citing *FedEx*, page 1).

The Office Action then states that "Kara, Theil, UPS® and FedEx® fail to disclose the use of a simultaneous display with [sic] shows the date and time of services [sic] Barnet [sic] discloses the use of a calendar which can be used for online purchasing of services (column 2, lines 63-67), where there is a graphical representation of date on one axis and time on another (See Figure 9)." *Office Action*, Topic No. 12, pgs. 5-6. The Office Action then concludes that "[i]t would have been obvious ... to have the

display of rates of Kara, Theil, UPS® and FedEx® with respect to day and time, include the day and time, [sic] as disclosed by Barnett, in order to provide a single integrated display that allows a user to order or purchase a system based on the calendar day and time." *Office Action*, Topic No. 12, p. 6 (citing *Barnett*, column 2).

REMARKS REGARDING SECTION 103(a) REJECTIONS

    '   The rejections under Section 103(a) have been carefully considered. For the reasons given, and authorities cited, below, it is respectfully asserted that none of the cited references, whether considered alone or in combination with any other reference of record, disclose, anticipate, teach or suggest all of the limitations of Claims 64-79; it is therefore respectfully requested that Claims 64-79 be reconsidered and allowed.

A.   ***The Printed Matter Rejection is Misplaced Because the Rejected Claims Do Not Merely Recite a Display, But Rather Recite, in Combination with Various Other Limitations, Displaying Rates***

The reasoning stated by the Office Action to support the rejections outlined above (that "[t]he way something is displayed, is not considered to be patentable over the prior art of record, therefore it would have been obvious ... to display all the calculated rates simultaneously for comparison purposes." (*Office Action*, Topic No. 6, p. 3; *Office Action*, Topic No. 11, p. 5)) is taken to be a printed matter rejection under Section 103(a). However, for the reasons given and the authorities cited below, it is respectfully asserted that a printed matter rejection under Section 103(a) is misplaced.

First, with regard to the aforementioned "printed matter" rejection, as the Office Action rightfully notes, the rejected claims are directed to computer systems. It is respectfully asserted that computer systems have been well established as being patentable subject matter under 35 U.S.C. § 101. In particular, it is respectfully asserted that the Claims of the present application are directed to patentable subject matter because the claimed subject matter is directed to a practical application in the technological arts, the purpose of which is to produce a real world useful result, namely, *e.g.*, as recited by Claim 64, for "...simultaneously displaying said first, second, third,

and fourth shipping rates to said user ...." *See, e.g., State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368, 1373 (Fed. Cir. 1998) (citations omitted) ("Congress intended § 101 to extend to 'anything under the sun that is made by man.'"); *id.* at 1372 ("The plain and unambiguous meaning of §101 is that any invention falling within one of the four stated categories of statutory subject matter may be patented, provided it meets the other requirements for patentability set forth in Title 35, i.e., those found in §§ 102, 103 and 112, P.2, n. 2."); MPEP §2106 II, A (the "purpose of this [section 101] requirement is to limit patent protection to inventions that possess a level of 'real world' value, as opposed to subject matter that represents nothing more than an idea or concept."); *id.* ("[Patent] Office personnel have the burden to establish a prima facie case that the claimed invention as a whole is directed to solely an abstract idea or to manipulation of abstract ideas or does not produce a useful result. Only when the claim is devoid of any limitation to a practical application in the technological arts should it be rejected under 35 U.S.C. 101.").

Further, it has long been recognized by the courts that "... a 'printed matter rejection' under [[section]] 103 stands on questionable legal and logical footing. Standing alone, the description of an element of the invention as printed matter tells nothing about the differences between the invention and the prior art or about whether that invention was suggested by the prior art. . . . [The Court of Customs and Patent Appeals], notably weary of reiterating this point, clearly stated that printed matter may well constitute structural limitations upon which patentability can be predicated." *In re Lowrey*, 32 F.3d at 1583 (quoting *Gulack*, 703 F.2d at 1385 n.8).

Moreover, Applicants respectfully disagree that a computer system programmed to display rates as recited, for example by Claim 64 can be legally considered to be "printed matter." The Office Action fails to cite any legal authority to support the asserted position.

Even assuming for the sake of argument that a display of rates by a computer system rates could be argued to constitute printed matter, it is respectfully submitted that the rejected Claims do not simply claim a display. Rather, Claim 64, for example, recites "displaying" rates. In particular, Claim 64 recites "...simultaneously displaying

said first, second, third, and fourth shipping rates to said user."

It is respectfully asserted that "...simultaneously displaying said first, second, third, and fourth shipping rates to said user ..." as claimed, for example, by Claim 64, is functionally distinguished from a recitation of a display alone.

"... [W]hen evaluating the scope of a claim, every limitation in the claim must be considered. USPTO personnel may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation. Instead, the claim as a whole must be considered." *Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility*, (United States Patent and Trademark Office; *Official Gazette* Notices for November 22, 2005; the "*Interim Guidelines*"), § II.C (*citing Diamond v. Diehr*, 450 U.S. 175, 188-89, 209 USPQ 1, 9 (1981) ("In determining the eligibility of respondents' claimed process for patent protection under Sec. 101, their claims must be considered as a whole. It is inappropriate to dissect the claims into old and new elements and then to ignore the presence of the old elements in the analysis. This is particularly true in a process claim because a new combination of steps in a process may be patentable even though all the constituents of the combination were well known and in common use before the combination was made.")); *accord In re Lowrey*, 32 F.3d 1579, 1582, 32 USPQ2d 1031, __ (Fed. Cir. 1994) ("The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art. *Gulack*, 703 F.2d at 1385. The PTO may not disregard claim limitations comprised of printed matter. *See Gulack*, 703 F.2d at 1384; *see also Diamond v. Diehr*, 450 U.S. 175, 191 (1981).")

In view of the mandate of the *Interim Guidelines* to consider every limitation of the claims, it is respectfully asserted that displaying shipping rates as claimed by the Claims is not subject to a printed matter rejection, and moreover, for the reasons given and authorities cited below, is non-obvious in view of, and patentable over, the references of record.

B.   _Displaying Shipping Rates as Claimed is Non-Obviousness_

The Office Action defends the rejections with the position that "Kara is fully capable of calculating rates for multiple carriers for multiple services, however, is not done simultaneously." _Office Action_, Topic No. 15, p. 7.

It is respectfully asserted that the aforementioned defense is, to the contrary, an acknowledgement that _Kara_ does not disclose, anticipate, teach or suggest the combination of limitations recited by the rejected Claims.

1.   Independent Claim 64

In particular, independent Claim 64, for example, is directed to a shipping management computer system; Claim 64 recites limitations for which the claimed shipping management computer system is programmed, including:

> receiving, from a user, a set of package specifications for a particular package that is to be delivered to a particular destination;
> determining a first shipping rate, said first shipping rate being a rate that a first carrier would charge to deliver said package to said destination according to a first delivery service;
> determining a second shipping rate, said second shipping rate being a rate that said first carrier would charge to deliver said package to said destination according to a second delivery service;
> determining a third shipping rate, said third shipping rate being a rate that a second carrier would charge to deliver said package to said destination according to a third delivery service;
> determining a fourth shipping rate, said fourth shipping rate being a rate that said second carrier would charge to deliver said package to said destination according to a fourth delivery service;
> simultaneously displaying said first, second, third, and fourth shipping rates to said user; and
> receiving a request from said user to ship said package to said destination via a particular delivery service, said particular delivery service being selected from a group consisting of: (A) said first delivery service; (B) said second delivery service; (C) said third delivery service, and (D) said fourth delivery service; and
> facilitating delivery of said package to said destination via said particular delivery service.

Even assuming for the sake of argument that a simultaneous display could be argued to constitute printed matter, in view of the mandate to consider all limitations of a

Claim by the *Interim Guidelines*, the holding of the Supreme Court in *Diamond*, and the holding of the Federal Circuit in *In re Lowrey*, it is respectfully asserted that the combination of determining first, second, third and fourth shipping rates as recited by independent Claim 64, and then simultaneously displaying those rates, and then receiving a request from a user to ship a package where, as claimed by Claim 64, the "particular delivery service being selected from ..." on of the delivery services for which rates were calculated, and then facilitating delivery of the package as claimed by Claim 64, are limitations, the combination of which is not disclosed, anticipated, taught or suggested by any combination of the references of record, including *Kara* and *Thiel*.

Further, as compared to the limitations of the rejected Claims, it is respectfully submitted that *Kara* discloses a pre-selection by a user of a service and then a subsequent calculation of rates for carriers for that particular pre-selected service. In particular, *Kara* discloses a system that requires that a user first pre-select a class and/or delivery "urgency". FIG. 7 of *Kara* depicts process element 712 that is labeled "Class/Urgency" and that contains the description "Select from different choices: first, third, fourth, bulk rate, priority mail, air mail, same day, overnight, next day, 2 days, 3 days". FIG. 8 of *Kara* depicts a display interface with a box 802 providing fields for Weight (Pounds and Ounces), Zone, Class, and a choice of Domestic or International. FIG. 8 of Kara also depicts a box 807, labeled as "Urgency" and containing the choices of "Same day", "Overnight", "Next day", "2 Days", "3 Days", and "Immaterial". The specification of *Kara* explains that, "[i]n step 712, the user selects the class and/or urgency of the item from the choices shown in box 802 and 807. It shall be appreciated that ones of the selections of class and urgency may substantially overlap and, therefore, selection of such an option from one of boxes 802 or 807 may also make a corresponding selection in the other one of boxes 802 or 807." *Kara*, col. 21, lines 1-7.

Kara discloses that "class and urgency information may be different for each of the shipping service providers and, accordingly, selection of a particular class[ ] or urgency criteria may be based at least in part on the particular shipping service provider(s) for which the user wishes the ... program to calculate the necessary postage.... Alternatively, the class and urgency information may be presented for

selection generically, as shown in FIG. 8, and the ... program operate to determine the corresponding fees for each of the particular shipping service providers automatically." *Kara*, col. 21, lines 8-20.

Whether the class and urgency information available for selection by the user is presented "generically" (as depicted in FIG. 8 of Kara), or is available for "selection ... based ... on the particular shipping service provider", *Kara* explains that, only after a selection of class and/or urgency is made are fees calculated and displayed.

> In order to present the user with information from which to make an informed choice as to a particular shipping service provider by which to ship the piece of mail or other item, the E-STAMP program may calculate the fees associated with a plurality of the available shipping service providers. Accordingly, the user may select shipping service providers of interest (not shown) in order to allow the E-STAMP program to determine the fees for only those shipping service providers. Thereafter, the E-STAMP program may calculate and display fees associated with shipping the item via the selected shipping service providers according to the desired shipping and/or delivery parameters, i.e., class, urgency, etc. Where a selected shipping service provider does not provide a desired shipping and/or delivery parameter, the E-STAMP program may indicate such and provide the fees for a service offered by that particular shipping service provider most near that desired by the user.

> However, in the preferred embodiment, the E-STAMP program automatically calculates the fees for each shipping service provider offering service commensurate with the desired shipping and/or delivery parameters. Additionally, the E-STAMP program may indicate other ones of the shipping service providers which do not provide a desired shipping and/or delivery parameter and provide the fees for a service offered by that particular shipping service provider most near that desired by the user, as well as indicate how their service differs from that desired.

Kara, col. 22, lines 20 – 48.

FIG. 8 of *Kara* depicts box 808 which is labeled "Selection & Comparison". In box 808 of FIG. 8 of *Kara*, the carriers "US Post", "Federal Express", "DHL", "UPS", "Purolator", and "Emery" are listed. To the left of each carrier is a box, with which to select one of the carriers. *See Kara*, col. 22, lines 53-54 ("...the user selects a particular shipping service provider, such as by checking a box associated therewith (shown in box 808) ..."). To the right of each carrier (shipping service provider) in box

808 is a dollar field for display of a shipping rate. _Kara_, FIG. 8. Importantly, only one dollar field is indicated per carrier.

Therefore, as clarified from the position stated in the _Office Action_ that "In the system of ... Kara and Theil the calculation of all the rates are done..." (_Office Action_, Topic 13, p. 6), it is respectfully submitted that Kara discloses calculating and displaying only a single shipping rate per carrier (shipping service provider) at a time, based on a user's pre-selection of either a generic class/urgency for all providers, or based on a user's pre-selection of a carrier-specific class/urgency for each provider.

Accordingly, it is respectfully asserted that _Kara_ does not disclose "... simultaneously displaying said first, second, third, and fourth shipping rates to said user ..." as recited by Claim 64 of the present application. Rather, for the reasons given above, it is respectfully submitted that although _Kara_ may disclose calculating a fee for a first service "urgency" by one carrier and another service "urgency" by another carrier, _Kara_ discloses calculating only a single fee per carrier at a time.

As compared to, _e.g.,_ independent Claim 64 of the present application which recites "... simultaneously displaying said first, second, third, and fourth shipping rates to said user ..." (_cf. also, e.g.,_ Claim 74), in order to obtain first, second, third and fourth shipping rates as recited by, e.g., Claim 64, using _Kara_, it is respectfully submitted that a user would need to first indicate a first "urgency", e.g., "Overnight" on FIG. 8 of _Kara_, so that the _Kara_ system would, according to the specification of _Kara_ (e.g., _Kara_, col. 22, lines 39 – 42), calculate the rates for the shipping service providers (depicted in FIG. 8 of Kara as "US Post", "Federal Express", "DHL", "UPS", "Purolator", and "Emery") via the indicated first "urgency". Once the system had calculated the rates, the user could, for example, write the rates, or print the screen showing the rates, for the first indicated "urgency".

Next, a user of _Kara_ would need to indicate a second "urgency", e.g., "Next day" on FIG. 8 of _Kara_, so that the _Kara_ system would, according to the specification of _Kara_ (e.g., _Kara_, col. 22, lines 39 – 42), calculate the rates for the shipping service providers (depicted in FIG. 8 of Kara as "US Post", "Federal Express", "DHL", "UPS", "Purolator", and "Emery") via the indicated second "urgency". Once the system had calculated the

rates, the user could, for example, write the rates, or print the screen showing the rates, for the second indicated "urgency".

Only when the _Kara_ user had completed the process of indicating the two successive "urgencies", obtaining the rates, and writing the rates or printing the screens, would the _Kara_ user be able to compile a piecemeal comparison of rates. Even then, it is respectfully asserted that neither the system of _Kara,_ nor the _Kara_ user, would have generated a simultaneous display of "... said first, second, third, and fourth shipping rates ..." to the user that would embody the other limitations claimed by, for example, Claim 64 of the present application.

The Office Action posits that _Thiel_ supports the rejection of the Claims under Section 103, stating that "Theil is not relied on for displaying the rates, merely storing them in one table." _Office Action_, Topic No. 14, p. 7. However, as further clarified below from the above quoted assertion of the Office Action, _Thiel_ stores only components for calculating shipping rates, not the shipping rates themselves.

In comparing the cited _Thiel Table_ to the claimed limitations of Claims 64-79, it is respectfully asserted that the contents of the cited _Thiel Table_ and the description by _Thiel_ of the use of the cited _Thiel Table_ as described by _Thiel_ are instructive.

At first glance, the cited _Thiel Table_ may appear to provide a simultaneous comparison of rates. However, it is respectfully submitted that under close inspection, the cited _Thiel Table_ provides a stored comparison of base rate components, not of shipping rates that have been determined by the claimed system (as claimed for example, by Claim 64).

As compared to storing rates "... to deliver said package to said destination ..." as recited by, e.g., Claim 64, the cited _Thiel Table_ is shown as containing shipping feature rate component entries for five (5) different carriers. _See Thiel_, col. 11, lines 1-13. For each of the five (5) different carriers (Carrier 1-5), the cited _Thiel Table_ shows a shipping feature rate component entry for each of the following shipping features: Destination Zone, Base Charge, Express Delivery, Added [Express Delivery] Charge, Return Receipt, Added [Return Receipt] Charge, Discount for greater than 100 items,

Discount for greater than 1000 items, and Discount for greater than 10000 items. _Id._ at col. 11, lines 1-13.

As compared to a simultaneous display of rates "...to deliver said package to said destination ..." as recited by, e.g., Claim 64, it is respectfully submitted that _Thiel_ describes the cited _Thiel Table_ as a _stored_ table of services and fee _components_ of various carriers. More specifically, it is respectfully submitted that _Thiel_ explains that the cited stored _Thiel Table_ is used by the _Thiel_ system to "... search[] the carriers which offer the desired services ..." (_Thiel_, col. 11, lines 22-23) and "... [perform] a fee optimization ... to reach the best price ..." (_Thiel_, col. 11, lines 29-30). That is, the cited _Thiel Table_ is used by the _Thiel_ system to identify carriers that would provide a user-pre-selected delivery service and user-requested shipping features and to calculate shipping rates for shipping a parcel; the cited _Thiel Table_ does not contain shipping rates "...to deliver said package to said destination ..." as recited by, e.g., Claim 64.

In summary, in view of the above-described disclosures of _Thiel_, it is respectfully asserted that, as compared to the limitations of Claim 64 for "... simultaneously displaying said first, second, third, and fourth shipping rates to said user ...", the _Thiel Table_ is not displayed at all, but rather is a stored table.

Yet further, as compared to the above-recited limitations of Claim 64 for "... determining a ... shipping rate ... to deliver said package to said destination ...", the _Thiel Table_ does not contain shipping rates determined by _Thiel_ "... to deliver said package to said destination ...", but rather stores shipment rating components, that are used by _Thiel_ as input for determinations of shipping rates for delivering particular packages to particular destinations.

The Office Action further posits that _Thiel_ supports the rejection of the Claims under Section 103, stating that "Thiel discloses the use of a system for calculating rates for multiple carriers for multiple services ..." (_Office Action_, Topic No. 5, p. 3; _Office Action_, Topic No. 10, p. 4) and that "Thiel also discloses that the system will walk the user through which service is wanted, however discloses displaying only the final rate for desired service for multiple carriers (Column 11, lines 46-54)" (_Office Action_, Topic No. 5, p. 3; _Office Action_, Topic No. 10, pgs. 4-5).

However, it is respectfully clarified that, like _Kara_, _Thiel_ discloses calculating shipping rates for a user-pre-selected delivery service level. In particular, _Thiel_ discloses a display of shipping costs (_e.g., Thiel_, col. 6, lines 53-55) by multiple carriers based on a user first selecting a type of shipment (express, air, priority, general, etc.; referred to in the Claims on Appeal as a delivery service). _See, e.g., Thiel_, col. 8, lines 58-66; see also, e.g., _Thiel_, col. 11, lines 15-18 (explaining that "[t]he user of the franking machine first defines the required services. This is done by entering the data with regard to the ship-to-zone (the destination zone) and the desired additional services such as express delivery (E), return receipt (R), etc.").

Yet further, as disclosed in _Thiel_ at column 11, lines 46-54, there is no dispute that _Thiel_ discloses displaying a calculated rate for a preferred carrier, and for a second and a third carrier as well. However, it is respectfully asserted that the disclosure of _Thiel_ at column 11, lines 46-54, when read together with the rest of the _Thiel_ specification, explains that after the system disclosed in _Thiel_ uses the shipping fee components stored _Thiel Table_ to calculate shipping rates for a user-pre-selected delivery service level for carriers that would support shipping a parcel according to the user's pre-selected requirements; _Thiel_ discloses providing a display of shipping costs (_e.g., Thiel_, col. 6, lines 53-55) only by multiple _carriers_ (_see, e.g., Thiel_, col. 8, lines 58-66). As compared to the limitations claimed, for example, by independent Claim 64, it is respectfully asserted that _Thiel_ does not disclose displaying a first shipping rate for a first delivery service and a second shipping rate for a second delivery service for a first carrier; nor does _Thiel_ disclose displaying a third shipping rate for a third delivery service and a fourth shipping rate for a fourth delivery service for a second carrier.

It is respectfully asserted that one advantage of a shipping management computer system according to various embodiments of the system claimed in Claim 64 is that such embodiments allow for a simultaneous display, and therefore a simultaneous cross-comparison by a user, of the various rates associated with multiple delivery services provided by each of a plurality of carriers. For example, such a system could be configured for simultaneously displaying: (1) the shipping rate that UPS would charge to deliver a package via overnight delivery; (2) the shipping rate that UPS

would charge to deliver the package via second day delivery; (3) the shipping rate that Federal Express would charge to deliver a package via overnight delivery; and (4) the shipping rate that Federal Express would charge to deliver the package via second day delivery. Such a display may be useful in allowing users to quickly compare the delivery services (and associated rates) of various carriers.

For the above-given reason and authorities, it is respectfully asserted that the above-cited limitations of independent Claim 64 are not disclosed, anticipated, taught or suggested by either *Thiel* or *Kara*, whether considered alone or in combination with any other reference of record.

2.   Independent Claim 74

For reasons similar to those described above with respect to Claim 64, it is respectfully asserted that neither *Thiel* nor *Kara*, whether considered alone or in combination with any other reference of record, disclose, anticipate, teach or suggest all of the limitations of Claim 74. Independent Claim 74 is directed to a shipping management computer system that is programmed for:

> identifying a first day on which a first carrier would deliver a particular package to a particular destination if said first carrier were to deliver said package to said destination via a first delivery service;
>
> identifying a second day on which said first carrier would deliver said package to said destination if said first carrier were to deliver said package to said destination via a second delivery service;
>
> identifying a third day on which a second carrier would deliver said package to said destination if said second carrier were to deliver said package to said destination via a third delivery service;
>
> identifying a fourth day on which said second carrier would deliver said package to said destination if said second carrier were to deliver said package to said destination via a fourth delivery service; and
>
> simultaneously displaying to a user:
>
> > (A) a first delivery schedule indicia indicating that said first carrier would deliver said package to said destination on said first day if said first carrier were to deliver said package to said destination via said first delivery service;
> >
> > (B) a second delivery schedule indicia indicating that said first carrier would deliver said package to said destination on said second day if said first carrier were to deliver said package to said destination via said second delivery service;

(C) a third delivery schedule indicia indicating that said second carrier would deliver said package to said destination on said third day if said second carrier were to deliver said package to said destination via said third delivery service; and

(D) a fourth delivery schedule indicia indicating that said second carrier would deliver said package to said destination on said fourth day if said second carrier were to deliver said package to said destination via said fourth delivery service.

As compared to the above-recited limitations of independent Claim 74 for "… identifying a … day on which a … carrier would deliver a particular package to a particular destination …", the stored _Thiel Table_ cited by the Office Action at column 11, lines 1-13 merely lists, for five (5) different carriers, such shipping features as Destination Zone, Base Charge, Express Delivery, Added [Express Delivery] Charge, Return Receipt, Added [Return Receipt] Charge, Discount for greater than 100 items, Discount for greater than 1000 items, and Discount for greater than 10000 items. _Thiel_, col. 11, lines 1-13. It is respectfully submitted that no dates or times are listed in the stored _Thiel Table_.

Further, it is respectfully asserted that the listing in the cited stored _Thiel Table_ of "Express Delivery" as a setting for each of five carriers, does not constitute "…identifying a … day on which a … carrier would deliver a particular package to a particular destination if said … carrier were to deliver said package to said destination via a … delivery service …" as recited by Claim 74 for various carriers and various delivery services. That is because, depending on each carrier's rules, the mere listing of an offering of a delivery service, such as an Express Delivery service, does not necessarily indicate any particular date for delivery. For example, if a shipment is initiated on a Friday, a weekend, or a day preceding a holiday, depending on a given carrier's rules regarding Saturday, Sunday, or holiday delivery, the shipment may not, be delivered by an Express Service on the day following the date on which the shipment was initiated.

Yet further, it is respectfully submitted that _Kara_ does not disclose a display of a day on which a carrier would delivery a particular parcel as recited by Claim 74. For the reasons described above with respect to _Thiel_, it is respectfully similarly asserted that

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Kara's display of such delivery services as "Overnight", "Next Day", and the like, does not constitute a display of a day on which a parcel would be delivered. For example, even if a user of the *Kara* system were to indicate the "Same Day" option, a display by *Kara* of the rates for that service level would not, depending on the drop-off or pick-up time of the package, indicate the day of delivery.

Still further, analogous to the reasons given above with respect to independent Claim 64, it is respectfully submitted that the stored *Thiel Table* is not displayed to the user, and therefore would not be properly held to disclose the limitations of Claim 74 for "...simultaneously displaying to a user ... delivery schedule indicia ...."

The Office Action asserts that "[b]oth UPS® and FedEx® disclose specific services where they are guaranteed delivery by a certain time in the day. It would have been obvious to ... include the time sensitive "urgency" services, as disclosed by FedEx® and UPS®, in order to ship thing and compete with a time advantage using guaranteed delivery times and to reduce costs, when delivery time is not of importance." *Office Action*, Topic No. 12, p. 5.

The *FedEx* reference amounts to nothing more than a general description of various services offered by FedEx® and rules that FedEx® applies to shipments. Specifically, *FedEx* lists a number of FedEx® delivery services along with a brief description of each FedEx® delivery service.

For example, *FedEx* describes "FedEx Priority Overnight®" as providing "...delivery by 10:30 a.m. the next business day to thousands of U.S. cities in our primary service are (noon to most of the rest). Shipments may weigh up to 150 lbs., and measure up to 119" length and up to 165" in length and girth combined ... Pickup and delivery Monday-Saturday". *FedEx*, p. 1.

As a further example, *FedEx* describes "FedEx Standard Overnight®" as providing "...delivery by 3:00 p.m. the next business day to thousands of U.S. cities in our primary service area (4:30 p.m. to most of the rest, Saturday delivery not available with this service). Shipment may weigh up to 150 lbs., and measure up to 119" in length and up to 165" in length and girth combined." *FedEx*, p. 1.

As yet another example, _FedEx_ describes "FedEx 2Day(SM)" as providing "delivery by 4:30 p.m. the second business day (7:30 p.m. to residential destinations) within the continental U.S. Shipments may weight up to 150 lbs., and measure up to 119" in length and up to 165" in length and girth combined." _FedEx_, p. 1.

It is respectfully submitted that there is no disclosure of a determination of a delivery schedule indicia or a calculation of shipping costs for delivery of a particular parcel in the _FedEx_ reference.

Similar to _FedEx_, _UPS_ provides a description of each of its services, but also provides a link, "Quick Cost Calculator", with each service description. According to the _UPS_ reference, the "Quick Cost Calculator" link appears to provide a user with the ability to click the link to obtain a calculation of shipping rates, and availability and delivery times, for the particular service with which the link appears.

More specifically, _UPS_ depicts multiple screen shots. Each _UPS_ screen shot describes a single UPS® delivery service. On each _UPS_ screen shot, that is, for each delivery service, _UPS_ shows a "Quick Cost Calculator" link described for use "to determine shipping rates, availability and delivery times" for the relevant delivery service. See, e.g., _UPS_, p. 2.

For example, one screen shot describes UPS® Next Day Air Early A.M. and provides a "Quick Cost Calculator" link to determine shipping rates, availability and delivery times for UPS® Next Day Air Early A.M. _UPS_, p. 2. The screen shot describing UPS® Next Day Air Early A.M. mentions that "[y]ou get guaranteed delivery by 8:00 a.m. to major U.S. cities and by 8:30 a.m. to most other U.S. cities (9:00 a.m. or 9:30 a.m. on Saturday)." _UPS_, p. 2.

Another screen shot describes UPS® Next Day Air and provides a "Quick Cost Calculator" link to determine shipping rates, availability and delivery times for UPS® Next Day Air. _UPS_, p. 4. The screen shot describing UPS® Next Day Air mentions "[w]e guarantee delivery by 10:30 a.m., noon, or end-of-day the next business day depending on destination (noon or 1:30 p.m. on Saturdays)." _UPS_, p. 4.

Yet another screen shot describes UPS® 2nd Day Air A.M. and provides a Quick Cost Calculator" link to determine shipping rates, availability and delivery times for

UPS® 2nd Day Air A.M. *UPS*, p. 6. The screen shot that describes UPS® 2nd Day Air A.M. mentions that "[w]hen you have commercial shipments that must arrive before noon the second business day, UPS 2nd Day Air A.M.™ is the right choice. Available to most metropolitan addresses throughout the 48 contiguous states." *UPS*, p. 6.

Trying to determine projected delivery dates would have required a *FedEx* user to investigate the specific FedEx® rules as those rules pertained to the user's particular shipping requirements. Further, even if a user were to investigate the relevant FedEx® rules, it is respectfully asserted that it would be possible for a user to misinterpret the rules or otherwise not be able to accurately determine delivery dates.

Regarding a date by which delivery would be expected, *FedEx* explains that Saturday delivery is not available for the "FedEx Standard Overnight®" service. *FedEx*, p. 1. That is, if a parcel is shipped on a Friday using FedEx Standard Overnight®, because delivery on Saturday is not available for that service, the parcel would not be delivered until the following Monday, or if the following Monday were a holiday, by the following Tuesday. Therefore, in order for a delivery *date* to be determined, a user of *FedEx* would need to consult a calendar (mentally or visually) to determine the delivery date on which a parcel shipped via, e.g., FedEx Standard Overnight® should be delivered. For example, if the user was shipping a package on, *e.g.*, a Friday, the user would need to identify the date of the following Monday, or if the following Monday were a holiday, the following Tuesday.

Yet further, in order for a delivery date to be determined, a user of *FedEx*, may, depending on the circumstances, need to consult a clock to determine the date of expected delivery of a parcel to be sent by FedEx Standard Overnight®. For example, if the user was shipping the package after a particular cut-off time, the package may not be delivered the following day -- that is, the package may be delivered two days after the shipment date.

The above-described steps that a *FedEx* user would have to take to determine a delivery date of a parcel to be shipped, *e.g.*, using FedEx Standard Overnight® are further evidence that *FedEx* does not disclose the above-recited limitations of Claim 74.

Further still, if a user of *FedEx* wanted to compare, across various FedEx® services, delivery dates and times of a particular parcel that the user wanted to ship, the user would need to determine a delivery date and time for each FedEx® service to be compared. The aforementioned steps that a *FedEx* user would have to take to compile a piecemeal comparison with an indication of delivery dates and times for a parcel using only a single carrier, *e.g.,* FedEx®, is yet further evidence that neither *FedEx* , nor the steps taken by a *FedEx* user, disclose the combination of the above-cited limitations of independent Claim 74.

Turning to the *UPS* reference, as with *FedEx*, *UPS* teaches that, even for "guaranteed" services (*See, e.g., Office Action*, Topic 12, p. 5 (stating that "[b]oth UPS® and FedEx® disclose specific services where they are guaranteed delivery by a certain time in the day.), different delivery dates may apply depending on the shipping and/or delivery particulars for shipping and delivering a particular parcel. For example, the *UPS* reference teaches that, notwithstanding the name of a delivery service, delivery guarantees may depend on the day of the week on which shipping occurs. For example, some UPS® delivery services support Saturday delivery; whereas others do not; Sunday delivery options are not indicated in *UPS* for any of the UPS® delivery services. *Compare, e.g., UPS*, p. 2 (describing, for UPS Next Day Air Early A.M.®, both a Saturday Delivery option and a Saturday Pickup option) and *UPS*, p. 4 (describing, for UPS Next Day Air®, both a Saturday Delivery option and a Saturday Pickup option), *with UPS*, p. 6 (describing, for UPS® 2nd Day Air A.M.®, a Saturday Pickup option, but with no mention of a Saturday Delivery option).

That is, assuming that the delivery address is to one of "most metropolitan addresses" to which delivery would be "Guaranteed Two-Day by 12 Noon" (*see, UPS*, p. 6), if a package were sent on a Thursday via UPS® 2nd Day Air A.M.®, even though the delivery service name "UPS® 2nd Day Air A.M.®" may imply that the delivery would be made by the second day, a Saturday, following the Thursday shipment day, according to *UPS*, Saturday delivery would not be available. Because a Saturday delivery option is not available for the "UPS® 2nd Day Air A.M.®" delivery service, then delivery for a package sent on a Thursday using the "UPS® 2nd Day Air A.M.®"

delivery service would not be available until the next day available for deliveries for the "UPS® 2nd Day Air A.M.®" delivery service -- which, because neither Saturday nor Sunday are indicated in *UPS* as delivery days for the "UPS® 2nd Day Air A.M.®" delivery service, would therefore not occur until, *e.g.*, the following Monday, or if the following Monday were a holiday, then possibly not until the following Tuesday.

The above-described variations in delivery days for various UPS® delivery services as dependent on specific shipping and/or delivery parameters is evidence that the mere listing of a delivery service by name, and/or a general statement of guarantee, are not a conclusive indication of a delivery date for a particular parcel to be shipped to a particular address.

The *UPS* reference shows a "Quick Cost Calculator" link on each separate UPS® delivery service website page. For example, for the UPS Next Day Air Early A.M.® delivery service, *UPS* states "Use the Quick Cost Calculator to determine shipping rates, availability and delivery times for UPS Next Day Air Early A.M." *UPS*, p. 2. As another example, for the UPS Next Day Air® delivery service, *UPS* states "Use the Quick Cost Calculator to determine shipping rates, availability and delivery times for UPS Next Day Air." *UPS*, p. 4. As a further example, for the UPS 2nd Day Air A.M.® delivery service, *UPS* states "Use the Quick Cost Calculator to determine shipping rates, availability and delivery times for UPS 2nd Day Air A.M." *UPS*, p. 6. Yet further, for the UPS 2nd Day Air® delivery service, *UPS* states "Use the Quick Cost Calculator to determine shipping rates, availability and delivery times for UPS 2nd Day Air." *UPS*, p. 8. For the UPS 3 Day Select® delivery service, *UPS* states "Use the Quick Cost Calculator to determine shipping rates, availability and delivery times for UPS 3 Day Select." *UPS*, p. 10. For UPS Ground, *UPS* states "Use the Quick Cost Calculator to determine shipping rates, availability and delivery times for UPS Ground Service." *UPS*, p. 12.

However, it is respectfully submitted that, even once a *UPS* user had obtained a set of rates and delivery dates (and times) for various delivery services offered by UPS®, doing so would not have provided the *UPS* user with rates and delivery dates (and times), for various delivery services offered by any other carrier.

Further, it is respectfully asserted that the aforementioned steps that a _UPS_ user would have to take to compile a piecemeal comparison with an indication of delivery dates (and times) for a parcel using only a single carrier, _e.g.,_ UPS®, is yet further evidence that neither _UPS_, nor the steps taken by a _UPS_ user, disclose the combination of the above-cited limitations of independent Claim 74.

Importantly, the problem resolved by various embodiments of the Claims of the present application is perfectly evidenced by the _UPS_ and _FedEx_ references cited by the _Office Action_ – namely, that the separate shipping rate and delivery schedule rules of each carrier had to be separately applied in order for a user to be able to try to compare shipping rates and associated projected delivery times and dates across various carriers and the various delivery services offered by those carriers. _See, e.g., Specification_, p. 2, lines 19-26 ("One of the problems in dealing with standalone Carrier systems is that, if the Shipper wants a particular parcel to be delivered to a particular destination under certain budgetary preferences and according to certain delivery schedule preferences, the Shipper must attempt to apply each Carrier's pricing and delivery schedule rules for each service offered by the Carrier to the particular parcel to be shipped. Each Carrier's pricing and delivery schedule rules for delivering parcels must be separately applied by the Shipper to shipment of a particular parcel to determine shipping rates and delivery schedules for each service offered by each Carrier.")

The Office Action then asserts that although "Kara, Theil [sic], UPS® and FedEx® fail to disclose the use of a simultaneous display with shows the date and time of services[,] Barnet[t] discloses the use of a calendar which can be used for online purchasing of services (column 2, lines 63-67), where there is a graphical representation of date on one axis and time on another (See Figure 9)." _Office Action_, Topic No. 12, pgs. 5-6. The Office Action then further asserts that "[i]t would have been obvious ... to have the display of rates of Kara, Theil [sic], UPS® and FedEx® with respect to day and time, include the day and time, as disclosed by Barnett, in order to provide a single integrated display that allows a user to order or purchase a system

based on the calendar day and time (See Barnett, column 2)." *Office Action*, Topic No. 12, p. 6.

Applicants respectfully disagree that the above-quoted assertion of obviousness is properly supported by sufficient evidence as required for an obviousness rejection under MPEP §706.02(j) and MPEP §2143. In particular, it is respectfully asserted that *Barnett* does not disclose any simultaneous display of rates (*see e.g.*, *Barnett*, FIG. 9). In fact, it is respectfully submitted that *Barnett* does not disclose any display of rates by the *Barnett* system.

It is true that *Barnett* discloses that "[o]nline purchasing and related actions can be associated with each event" (*Barnett*, Abstract). However, *Barnett* explains that the referred-to purchases would be done using links. *See, e.g., Barnett*, col. 2, lines 65-67 ("In addition, purchases of products, services, or tickets can be effected using links associated with displayed events."); *see also, e.g., Barnett*, col. 14, lines 13-17 ("In another embodiment, a link may be provided for making a purchase associated with a particular event. For example, if the event is a concert, a link to an on-line ticketing service maybe provided, for purchasing tickets to the concert."). It is respectfully asserted that the absence from the disclosure of *Barnett* of a display of price for a calendared event, and the disclosure of *Barnett* that a link to a separate service may be provided for making a purchase associated with a calendared event are evidence that *Barnett* did not contemplate that the system of *Barnett* would itself associate a price with an event calendared by the *Barnett* system.

Further, even assuming for the sake of argument that it could be argued that *Barnett* somehow suggested showing rates, *Barnett* was nevertheless not properly combined with the other references because even if a *Barnett* calendar were to depict rates, the rates would be for the various events calendared, not for the single event to "... deliver a particular package to a particular destination ..." as recited by Claim 74. In particular, as compared to providing a display of rates for the single event to "... deliver a particular package to a particular destination ..." as recited by Claim 74, the subject matter of *Barnett* is a calendaring system for producing calendars that show a schedule of many different events. More specifically, *Barnett* discloses "... provid[ing] a multi-

layered calendaring system wherein *events belonging to different categories...*". <u>Barnett</u>, col. 2, lines 27-28 (emphasis added).

As compared to the references of record, it is respectfully asserted that one advantage of a shipping management computer system according to various embodiments of the system claimed in new Claim 74 is that such embodiments allow for a simultaneous cross-comparison of the various schedules according to which a package would be delivered via multiple delivery services provided by each of a plurality of carriers. For example, such a system could be configured for simultaneously displaying: (1) the date on which UPS would deliver a package via an "overnight" delivery service; (2) the date on which UPS would deliver the package via a "second day" delivery service; (3) the date on which Federal Express would deliver the package via an "overnight" delivery service; and (4) the date on which Federal Express would deliver the package via a "second day" delivery service. Such a display may be useful in allowing users to quickly compare the dates on which a package would actually be delivered if the user were to send the package via various delivery services. This can be especially useful if different carriers have different polices regarding, for example, whether a package sent via overnight delivery on a Friday would be delivered on the next weekday (Saturday) or on the next business day (Monday).

For the above-given reason and authorities, it is respectfully asserted that the above-cited limitations of independent Claim 74 are not disclosed, anticipated, taught or suggested by any of the references of record, whether considered alone or in combination with any other reference of record.

C.   *The Asserted Conclusion of Obviousness is Not Supported by Sufficient Evidence as Required by MPEP §706.02(j) and MPEP §2143*

Applicants respectfully disagree with the above-quoted conclusion in the Office Action that even though "Kara and Theil [sic] fail to disclose the 'simultaneous' display of shipping charges for each service of each carrier.... It would have been obvious ... to display all charges simultaneously." <u>Office Action</u>, Topic No. 6, p. 3.

Further, Applicants respectfully disagree that the above-quoted assertion of obviousness is properly supported by sufficient evidence as required for an obviousness rejection under MPEP §706.02(j) and MPEP §2143.

Moreover, it is respectfully asserted that the description of the disparate features that "Kara disclose the use of calculating and displaying rates for specific services, for multiple carriers, but fails to disclose the simultaneous display of rates for each carrier that includes rates of different services ..." (*Office Action*, Topic No. 5, p. 3; *Office Action*, Topic No. 10, p. 4), and that "Kara and Theil [sic] fail to disclose the 'simultaneous' display of shipping charges for each service of each carrier ..." (*Office Action*, Topic No. 6, p. 3; *Office Action*, Topic No. 11, p. 5), is evidence that the above-quoted conclusion of obviousness is based on using the present application as a roadmap to assert obviousness.

It is respectfully asserted that using the present invention as a roadmap to pick and choose disparate portions of the cited references, asserting characterizations of those references that are not supported by the references themselves, and then, even acknowledging the complete absence in the asserted combination of the references of the claimed limitations, asserting that the claimed limitations would be obvious, is proscribed. In particular, it is respectfully submitted that "... decomposing an invention into its constituent elements, finding each element in the prior art, and then claiming that it is easy to reassemble these elements into the invention, is a forbidden *ex post* analysis." *In re Mahurkar Patent Litigation*, 831 F. Supp. 1354, 1374-75, 28 U.S.P.Q.2d (BNA) 1801, 1817 (N.D. Ill. 1993), *aff'd*, 71 F.3d 1573, 37 U.S.P.Q.2d 1138 (Fed. Cir. 1995) (Opinion by Judge Easterbrook; "With hindsight the transistor is obvious; but devising the transistor was still a work of genius. An invention lies in a combination of elements that are themselves mundane. 'Virtually all inventions are combinations and virtually all are combinations of old elements.' ...(Citations omitted) ....").

It is respectfully submitted that the Office Action's assertion of obviousness combines the references, but at the same time concedes that none of them, and indeed, not even the combination of them, disclose a simultaneous display. *See, e.g., Office Action*, Topic No. 15, p. 7 ("Kara is fully capable of calculating rates for multiple carriers

for multiple services, however is not done simultaneously ..."). It is respectfully asserted that the Office Action's concession that a simultaneous display as claimed by the rejected Claims is completely absent from the references cited, is strong evidence, and indeed a concession, that such a simultaneous display is _not_ obvious, and is further a concession, and strong evidence, that "... simultaneously displaying said first, second, third, and fourth shipping rates to said user ...," as claimed, for example, Claim 64, is also completely absent from the references cited and is therefore _not_ obvious.

CONCLUSION

Because, as respectfully asserted above, none of the cited references, whether considered alone or in combination, disclose, anticipate, teach or suggest all of the limitations of independent Claims 64 and 74, it is respectfully asserted that none of the cited references, whether considered alone or in combination, disclose, anticipate, teach or suggest all of the limitations of the claims that are dependent on Claims 64 and 74.

For the foregoing reasons and authorities, it is respectfully asserted that the invention disclosed and claimed in the present application is not fairly taught by any of the references of record, taken either alone or in combination, and that the application is in condition for allowance. Accordingly, reconsideration and allowance of the application are respectfully requested.

Respectfully submitted,

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